

REMARKS

Applicants have carefully considered the June 30, 2009 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-9 are pending in this application.

In response to the Office Action dated June 30, 2009, claims 1-9 have been amended. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification, including [0066] of the published version of the present application. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

The Examiner objected to the specification, but did not identify any discrepancies in the specification. Applicants submit that no corrections to the specification are necessary at the present time. Reconsideration and withdrawal of the objection are therefore solicited.

Claims 1-2 and 4-9 were rejected under 35 U.S.C. § 102(b) as being anticipated over Nakamura et al. (U.S. Pat. App. Pub. No. 2003/0070450, hereinafter “Nakamura”). Applicants traverse.

Dependent claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of Nakamura et al. (U.S. Pat. No. 6,324,871, hereinafter “Nakamura II”). Applicants traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). There are significant differences between the claimed method and the method disclosed by Nakamura that would preclude the factual determination that Nakamura identically describes the claimed subject matter within the meaning of 35 U.S.C. § 102.

In the method of Nakamura, the glass particle synthesizing conditions of the burners arranged at both ends are changed to have a greater deposition amount of glass particles per unit time in part or all of its movement range than the other burners. Abstract. The method produces a soot body which has a long effective portion and short taper portions (ineffective portions) formed at both ends. See [0002].

In the method of the present subject matter, the condition for the deposition is altered with respect to each of the plurality of burners for producing a glass-particle-deposited body having a longitudinally uniform shape with a small diameter variation.

The above argued difference between the claimed subject matter undermines the factual determination that Nakamura discloses the method identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d

1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 86 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of under 35 U.S.C. § 102 for lack of novelty as evidenced by Nakamura is not factually viable and, hence, solicit withdrawal thereof.

Nakamura II fails to remedy the above argued deficiency of Nakamura. Dependent claim 3 is free from the applied prior art in view of its dependency from claim 1. Reconsideration and withdrawal of the rejection of claim 3 are solicited.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck  
Registration No. 51,321

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 BKS:idw  
Facsimile: 202.756.8087

Date: September 24, 2009

Please recognize our Customer No. 20277  
as our correspondence address.